

Appl. No. : **10/774,062**
Filed : **February 6, 2004**

REMARKS

Claims 1, 2, and 13-20 are pending in the present application. Independent claim 13 has been amended to properly introduce the acronym "SERS" as "Surface Enhanced Raman Scattering." In addition, the phrase "for further data processing" in the claim has been removed. Dependent claim 16 has been amended to read "the near field SERS substrate" instead of "the SERS substrate." This amendment is supported by claim 13, from which claim 16 depends. No new matter is added by any of these amendments.

Claim Objections

Claims 13-20 were objected to for reciting the term "SERS" without first identifying what the acronym means. Applicant has amended independent claim 13 to properly introduce the acronym as "Surface Enhanced Raman Scattering."

Claim Rejections under 35 U.S.C. §112

Claims 13 and 16 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 13 was rejected for reciting the phrase "for further data processing," which the Examiner found to be indefinite in terms of the metes and bounds embraced by the limitation. Without acquiescing in the rejection, Applicant has removed the phrase from Claim 13.

Claim 16 was rejected for reciting the phrase "the SERS substrate," which the Examiner found lacking in antecedent basis. Applicant has amended Claim 16 to read "the near field SERS substrate" to provide proper antecedent basis. In view of these changes, Applicants submit that the rejection under 35 U.S.C. § 112 should be withdrawn.

Claim Rejections under 35 U.S.C. §101

Claims 1 and 2 were rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,376,177 ("the '177 patent"). The Examiner found that the claims of the instant application were identical in scope to claims 1 and 2 of the '177 patent. Applicant respectfully disagrees with the Examiner and submits that claims 1 and 2

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of the '177 patent have a different scope than the claims of this application and thus do not claim the same invention. For example, claim 1 of the '177 patent recites "[a]n analytical method for determining whether an *unlabeled* DNA sample comprises double-stranded DNA, said method comprising analyzing the DNA sample *associated with an SERS substrate*." On the other hand, claim 1 of the instant application recites "[a]n analytical method for determining whether a DNA sample comprises double-stranded DNA, said method comprising analyzing the DNA sample." Thus, in comparison to pending claim 1, the method claimed in claim 1 of the '177 patent recites *unlabeled* DNA and analyzes the DNA sample in association *with an SERS substrate*. Claim 2 of the '177 patent depends from claim 1 and thus has all of the features thereof. Similarly, claim 2 of the present application depends from claim 1 and thus the differences in the independent claims are reflected in the dependent claims as well. In view of these differences, Applicant submits that the same invention is not claimed in claims 1 and 2 of the present application and claims 1 and 2 of the '177 patent and requests withdrawal of this rejection.

Claims 13-20 were rejected under 35 U.S.C. §101 on the ground of nonstatutory obviousness-type double-patenting over claims 3-10 of the '177 patent. The Examiner found that the embodiments of claims 3-10 of the '177 patent are drawn to species which anticipate the genus embraced by the instant claims 13-20. Without acquiescing in the rejection, a Terminal Disclaimer over the '177 patent is submitted herewith. Thus, Applicant requests withdrawal of this rejection as well.

Conclusion

Applicant submits that the present application is in condition for allowance and respectfully requests an early action to that effect. If any issues remain, the Examiner is invited


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to contact Applicant's counsel at the number provided below in order to resolve such issues promptly.

Respectfully submitted,

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